

REMARKS

Claims 1 and 2 are amended herein. Claims 3-7 are canceled. Support for the amendment is found, for example, in the original claims. Upon entry of the amendment, claims 1, 2 and 8 will be all of the claims pending in the application. No new matter is presented.

I. Claim Rejection under 35 U.S.C. § 103(a)

The Office Action indicates that claims 1-4 and 6-8 are again rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Sato et al EP 1 211 242, and Sato et al JP 2001-151749.

Applicants respectfully traverse the rejection for the reasons of record and submit that the Examiner has engaged in improper hindsight reasoning as there is no teaching or suggestion in the cited references to make the compounds of the present invention, whether taken alone or in combination. Additionally, Applicants submit that the claimed compounds provide unexpectedly superior effects in view of their sleep inducing activity.

Contrary to the Examiner's assertion, the skilled person would not randomly combine distinct features of the substituents of the prostaglandin derivatives disclosed in the cited references to arrive at the compounds of the present invention.

It is not obvious from Sato '749 that prostaglandin derivatives, wherein a sulfur containing substituent further comprising an ethynylene group is connected to the cyclopentane ring via a -CH₂- group, also have activity as sleep inducing agents.

Sato '242 lacks the ethynylene group in the sulfur containing substituent of the cyclopentane ring and therefore the sleep inducing effects of the present compounds could not have been expected.

Further, neither reference recognizes the unexpectedly superior sleep inducing effects of the present compounds due to this difference in the structure. It could also not be foreseen by the person skilled in the art, that the prostaglandin derivatives as claimed show a sleep inducing effect since the claimed compounds are structurally modified with regard to the prior art compounds and the effect of the structural modification could not have been predicted.

Furthermore, neither Sato '749 nor Sato '242 teaches or suggests modification of the prior art compounds in the direction of the present invention to provide prostaglandin derivatives with a sleep inducing effect. Thus, the present invention is patentable over the cited references, whether taken alone or in combination.

Accordingly, Applicants respectfully request withdrawal of the rejection.

II. Double Patenting

The Office Action indicates that claims 1-4 and 5-8 are again provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/493,693 for the reasons of record. The Examiner maintains his position that the claims are not patentably distinct from each other because they generically overlap.

Applicants request the Examiner to hold the obviousness-type double patenting rejection in abeyance.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No.: 10/521,115

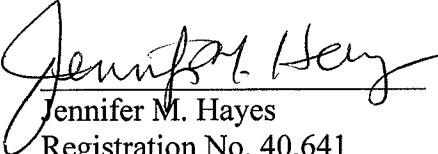
Attorney Docket No.: Q84913

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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